

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application Serial No. .... 10/002,354  
Filing Date ..... October 30, 2001  
Inventorship ..... Jeffrey G. Wiley  
Applicant/Appellant ..... Hewlett-Packard Company  
Group Art Unit ..... 2624  
Examiner ..... Murphy, Dillon J.  
Confirmation No. .... 4969  
Attorney's Docket No. .... 10016465-1  
Title: Document Delivery Methods and Multifunction Device Therefor

**APPEAL BRIEF**

To: MS Appeal Brief - Patents  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

As required under 37 C.F.R. §41.37(a), this brief is filed within two months of the Notice of Appeal filed in this case on November 17, 2006, and is in furtherance to the Notice of Appeal.

This brief contains items under the following headings as required by 37 C.F.R. §41.37 and M.P.E.P. §1206:

- I. Real Party In Interest
- II. Related Appeals, Interferences, and Judicial Proceedings
- III. Status of Claims
- IV. Status of Amendments
- V. Summary of Claimed Subject Matter
- VI. Grounds of Rejection to be Reviewed on Appeal
- VII. Argument
- VIII. Claims Appendix
- IX. Evidence Appendix
- X. Related Proceedings Appendix

## **I. REAL PARTY IN INTEREST**

The real party in interest for this appeal is Hewlett-Packard Development Company, L.P., a Texas Limited Partnership having its principal place of business in Houston, Texas.

## **II. RELATED APPEALS, INTERFERENCES, AND JUDICIAL PROCEEDINGS**

There are no other appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in this appeal.

## **III. STATUS OF CLAIMS**

### **A. Total Number of Claims in Application**

There are 25 claims pending in this application (Claims 1-25).

### **B. Current Status of Claims**

1. Claims canceled: None
2. Claims withdrawn from consideration but not canceled: None
3. Claims pending: 1-25
4. Claims allowed: None
5. Claims rejected: 1-25

### **C. Claims on Appeal**

The claims on appeal are claims 1-25.

#### **IV. STATUS OF AMENDMENTS**

Appellant last amended the claims in an Amendment and Response filed on June 28, 2006. Therefore the claims on appeal (as reflected in the claim appendix) are the claims presented in the Amendment and Response filed on June 28, 2006 and have already been entered.

#### **V. SUMMARY OF CLAIMED SUBJECT MATTER**

According to claim 1, a document delivery method (FIG. 6) comprising identifying different types of network destinations (140-143 in FIG. 1; p. 4, ll. 13-15; p. 5, ll. 5-21; p. 9, l. 4 to p. 10, l. 10) for receiving a document (110 in FIG. 1; p. 4, ll. 15-17; p. 5, ll. 17-25; p. 7, ll. 20 to p. 8, l. 21) based on preferred mode of receipt by the recipient. The method also comprising formatting said document (110 in FIG. 1) for each of said different types of network destinations (140-143 in FIG. 1) without re-imaging said document (110 in FIG. 1). The method also comprising automatically configuring at least one property (p. 13, l. 16 to p. 14, l. 6) of said document (110 in FIG. 1) based on said different types of network destinations (140-143 in FIG. 1) for optimizing output of said document (110 in FIG. 1) at said different types of network destinations (140-143 in FIG. 1). The method also comprising sending said formatted document (110 in FIG. 1) to each of said different types of network destinations (140-143 in FIG. 1) from a multifunction device (100 in FIG. 1; p. 4, ll. 12-22; p. 6, l. 26 to p. 7, l. 19).

According to claim 11, a document delivery method (FIG. 6) comprising converting a printed document (110 in FIG. 1; p. 4, ll. 15-17; p. 5, ll. 17-23; p. 7, ll. 20 to p. 8, l. 21) to an electronic document (120 in FIG. 1; p. 4, ll. 15-17; p. 5, ll. 23-25; p. 7, ll. 20 to p. 8, l. 21) only once with a multifunction device (100 in FIG. 1; p. 4, ll. 12-22; p. 6, l. 26 to p. 7, l. 19). The method also comprising identifying preferred network destinations (140-143 in FIG. 1; p. 4, ll. 13-15; p. 5, ll. 5-21; p. 9, l. 4 to p. 10, l. 10) for each of a plurality of recipients to receive

said electronic document (120 in FIG. 1). The method also comprising formatting said electronic document (120 in FIG. 1) for different types of said preferred network destinations (140-143 in FIG. 1). The method also comprising automatically configuring at least one document property (p. 13, l. 16 to p. 14, l. 6) for optimizing output of said document (120 in FIG. 1) by different types of said preferred network destinations (140-143 in FIG. 1). The method also comprising sending said formatted electronic document (120 in FIG. 1) from said multifunction device (100 in FIG. 1) to each of said plurality of recipients.

According to claim 18, a multifunction device (100 in FIG. 1; p. 4, ll. 12-22; p. 6, l. 26 to p. 7, l. 19) comprising computer-readable media operatively associated with said multifunction device (100 in FIG. 1) and having computer-readable program code thereon including program code for identifying different types of network destinations (140-143 in FIG. 1; p. 4, ll. 13-15; p. 5, ll. 5-21; p. 9, l. 4 to p. 10, l. 10) to receive a document (110 in FIG. 1; p. 4, ll. 15-17; p. 5, ll. 17-25; p. 7, ll. 20 to p. 8, l. 21), program code for automatically determining at least one document property (p. 13, l. 16 to p. 14, l. 6) for optimizing output at each of said different types of network destinations (140-143 in FIG. 1), program code for formatting the at least one document property of said document (110 in FIG. 1) for each of said different types of network destinations (140-143 in FIG. 1), and program code for sending said formatted document (120 in FIG. 1; p. 4, ll. 15-17; p. 5, ll. 23-25; p. 7, ll. 20 to p. 8, l. 21) from said multifunction device (100 in FIG. 1) to each of said different types of network destinations (140-143 in FIG. 1), wherein said document (110 in FIG. 1) is imaged only once for delivery to each of said different types of network destinations (140-143 in FIG. 1).

The summary is set forth in several exemplary embodiments that correspond to the independent claims. It is noted that no dependent claims containing means plus function are argued separately. Discussions about

elements and recitations to these claims can be found at least at the cited locations in the specification and drawings.

## **VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL**

The Final Office Action rejected claim 18 under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,577,907 to Czyszczewski, et al. (hereinafter referred to as “Czyszczewski”). The Final Office Action also rejected claims 1-7, 11-14, and 19-23 under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski in view of U.S. Patent No. 6,782,415 to Quine (hereinafter referred to as “Quine”). The Final Office Action further rejected claims 8-10, 15-17, 24 and 25 under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski in view of Quine and further in view of U.S. Patent No. 6,343,327 to Daniels, Jr. et al. (hereinafter referred to as “Daniels”). Appellant requests the Board to review each of these grounds of rejection.

## **VII. ARGUMENT**

### Rejection under 35 U.S.C. §102(e)

Claim 18 stands rejected under 35 U.S.C. §102(e) as being anticipated by Czyszczewski.

It is well settled that invalidity for anticipation requires that a single prior art reference disclose each claim recitation. Every element must be literally present, arranged as in the claim.

### Independent Claim 18

Claim 18 recites “program code for automatically determining at least one document property for optimizing output at each of said different types of

network destinations, [and] program code for formatting the at least one document property of said document for each of said different types of network destinations” [emphasis added]. Czyszczewski fails to disclose at least these recitations.

The Office Action relies on col. 8, lines 61-64 in Czyszczewski. However, this citation states that “Step E converts the incoming ASCII data into Adobe PostScript data.” There is no teaching or suggestion that the multifunction device automatically determines at least one document property for optimizing output. It simply states that the data type is changed.

The Office Action also relies on Figure 9D in Czyszczewski as disclosing these recitations. However, this figure shows a user interface where a user can select between PDF and Text formats. The Office Action also relies on col. 7, lines 48-54 in Czyszczewski as disclosing these recitations. However, this citation simply discloses converting scanline information to a digital representation of the data. None of these citations teach or suggest program code for automatically determining at least one document property for optimizing output and then program code for formatting the document property. Again, these citations simply disclose that the data type is changed.

Changing between data types is different from formatting properties of the document, e.g., from black/white to color as discussed in Appilcant’s specification on page 14, lines 1-4.

Apparently recognizing these deficiencies, the Office Action then states that “formatting inherently automatically determines and configures a document property.” By relying on inherency, the Office Action is admitting that the claim recitations are not expressly shown in the cited references. Appellant agrees with this admission. However, the Office Action failed to

provide any evidence to support this interpretation of the reference. Appellant respectfully traverses this position.

In order to support a rejection based upon the inherent limitations that are not expressly disclosed in a prior art reference, more than a summary statement that the recitations are inherent is required. It must be shown that the undisclosed information was known by those of ordinary skill in the art to be present in the reference.

Appellant contends that the claim recitations are not inherent in the cited references or otherwise considered common knowledge to those having ordinary skill in the art. To the contrary, Czyszczewski expressly states (col. 7, lines 48-50) and shows (Figure 9D) that the user must select a document format, and says nothing of configuring a document property. Therefore, it is not inherent in Czyszczewski to automatically determine at least one document property for optimizing output at each of the different types of network destinations.

In the Response to Arguments section, the Final Office Action states that Czyszczewski discloses automatically (inherently) converting incoming ASCII data to PostScript data, and that by defining placement on a page, for example, that this is a document property. Appellant disagrees that this is a sufficient showing that Czyszczewski discloses, in the context of the claim, automatically determining at least one document property for optimizing output at each of the different types of network destinations.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 18 is anticipated by Czyszczewski.

#### Rejection under 35 U.S.C. §103(a) - Czyszczewski and Quine

Claims 1-7, 11-14, and 19-23 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski in view of Quine.

It is well settled that three basic criteria must be met to support a rejection under 35 U.S.C. §103(a). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. §2143.

#### Independent Claim 1

Claim 1 recites “automatically configuring at least one property of said document based on said different types of network destinations for optimizing output of said document at said different types of network destinations” (emphasis added). Czyszczewski fails to disclose at least these recitations as discussed in more detail above for claim 18. Quine also fails to disclose at least these recitations.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 1 is obvious in view of Czyszczewski and Quine.

#### Dependent Claims 2-7

Claims 2-7 depend from claim 1, which is believed to be allowable. Therefore, claims 2-7 are also believed to be allowable for at least the same reasons as claim 1.

#### Independent Claim 11

Claim 11 recites “formatting said electronic document for different types of said preferred network destinations” and “automatically configuring at least one document property for optimizing output of said document by different types of said preferred network destinations” (emphasis added). Czyszczewski fails to disclose at least these recitations as discussed in more detail above for claim 18. Quine also fails to disclose at least these recitations.

For at least the foregoing reasons, the Examiner has failed to establish that independent claim 11 is obvious in view of Czyszczewski and Quine.

#### Dependent Claims 12-14

Claims 12-14 depend from claim 11, which is believed to be allowable. Therefore, claims 12-14 are also believed to be allowable for at least the same reasons as claim 11.

#### Dependent Claims 19-23

Claims 19-23 depend from claim 18, which is believed to be allowable as discussed above with regard to the Section 102 rejection. Therefore, claims 19-23 are also believed to be allowable for at least the same reasons as claim 18.

#### Rejection under 35 U.S.C. §103(a) – Czyszczewski, Quine, and Daniels

Claims 8-10, 15-17, 24 and 25 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszczewski in view of Quine and further in view of Daniels.

Again, it is well settled that three basic criteria must be met to support a rejection under 35 U.S.C. §103(a). First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art cited must teach or suggest all the claim limitations. *See* M.P.E.P. §2143.

#### Dependent Claims 8-10

Claims 8-10 depend from claim 1, which is believed to be allowable as discussed above for the Section 103 rejection in view of Czyszczewski and Quine. Therefore, claims 8-10 are also believed to be allowable for at least the same reasons as claim 1.

#### Dependent Claims 15-17

Claims 15-17 depend from claim 11, which is believed to be allowable as discussed above for the Section 103 rejection in view of Czyszczewski and Quine. Therefore, claims 15-17 are also believed to be allowable for at least the same reasons as claim 11.

#### Dependent Claims 24-25

Claims 24-25 depend from claim 18, which is believed to be allowable as discussed above with regard to the Section 102 rejection. Therefore, claims 24-25 are also believed to be allowable for at least the same reasons as claim 18.

Conclusion

For the reasons provided herein, Appellant respectfully requests the Board to rule that the rejections of the claims are improper.

Respectfully Submitted,

Dated: 1-15-2007

By: Mark D. Trenner

Mark D. Trenner

Reg. No. 43,961

(720) 221-3708

## VIII. CLAIMS APPENDIX

1. A document delivery method comprising:
  - identifying different types of network destinations for receiving a document based on preferred mode of receipt by the recipient;
  - formatting said document for each of said different types of network destinations without re-imaging said document;
  - automatically configuring at least one property of said document based on said different types of network destinations for optimizing output of said document at said different types of network destinations; and
  - sending said formatted document to each of said different types of network destinations from a multifunction device.
2. The method of claim 1, wherein sending said formatted document to each of said different types of network destinations is via serial transmission.
3. The method of claim 1, further comprising converting said document to electronic format, wherein said electronic document is formatted and sent.
4. The method of claim 1, wherein identifying said different types of network destinations is based at least in part on a user selection.
5. The method of claim 1, wherein identifying said different types of network destinations is based at least in part on a user-sorted type of network destination.
6. The method of claim 1, wherein formatting said document is automatically determined based at least in part on a property of the different types of network destinations.

7. The method of claim 1, wherein formatting said document is based at least in part on a property of the document.

8. The method of claim 1, further comprising resending said document to a next preferred network destination for the same recipient upon a predetermined condition being satisfied.

9. The method of claim 8, wherein said predetermined condition is satisfied when said document is undeliverable to said at least one of said different types of network destinations.

10. The method of claim 8, wherein resending said document is according to a user-selected cycle function.

11. A document delivery method comprising:

- converting a printed document to an electronic document only once with a multifunction device;

- identifying preferred network destinations for each of a plurality of recipients to receive said electronic document;

- formatting said electronic document for different types of said preferred network destinations;

- automatically configuring at least one document property for optimizing output of said document by different types of said preferred network destinations; and

- sending said formatted electronic document from said multifunction device to each of said plurality of recipients.

12. The method of claim 11, wherein sending said formatted document to each of said different types of network destinations is via serial transmission.

13. The method of claim 11, wherein identifying said different types of network destinations is based at least in part on a user-sorted type of network destination.

14. The method of claim 11, wherein formatting said electronic document is automatic based at least in part on the type of said network destination.

15. The method of claim 11, further comprising resending said electronic document to the same recipient at another preferred network destination upon a predetermined condition being satisfied.

16. The method of claim 15, further comprising satisfying said predetermined condition when said electronic document is undeliverable to said at least one of said different types of network destinations.

17. The method of claim 15, wherein resending said electronic document is in response to a user-selected cycle function.

18. A multifunction device comprising computer-readable media operatively associated with said multifunction device and having computer-readable program code thereon including program code for identifying different types of network destinations to receive a document, program code for automatically determining at least one document property for optimizing output at each of said different types of network destinations, program code for formatting the at least one document property of said document for each of said different types of network destinations, and program code for sending said formatted document from said multifunction device to each of said different types of network destinations, wherein said document is imaged only once for delivery to each of said different types of network destinations.

19. The multifunction device of claim 18, further comprising an interface for receiving at least one user selection, wherein said program code for identifying said different types of network destinations bases said identification at least in part on said at least one user selection and at least in part on a recipient preference for receiving said document.

20. The multifunction device of claim 19, wherein said computer-readable program code comprises program code for sorting said different types of network destinations based on said at least one user selection.

21. The multifunction device of claim 18, further comprising a computer-readable address book for identifying said different types of preferred network destinations.

22. The multifunction device of claim 18, wherein said computer-readable program code comprises program code for configuring a property of said document for each of said different types of network destinations.

23. The multifunction device of claim 18, further comprising program code for converting said document to electronic format.

24. The multifunction device of claim 18, wherein said computer-readable program code comprises program code for resending said document to a same recipient at an alternate network destination upon a predetermined condition being satisfied.

25. The multifunction device of claim 24, wherein said predetermined condition is satisfied when said document is undeliverable to said at least one of said different types of network destinations.

**IX. EVIDENCE APPENDIX**

Not applicable.

**X. RELATED PROCEEDINGS APPENDIX**

Not applicable.